

### **REMARKS/ARGUMENTS**

Prior to entry of this amendment, claims 1-11, 13-21, 23-31, and 33-36 were pending in this application. No claims have been amended, no claims have been canceled and no claims have been added herein. Therefore, claims 1-11, 13-21, 23-31, and 33-36 remain pending in this application. Applicants respectfully request reconsideration of this application for at least the reasons presented below.

#### **35 U.S.C. § 101 Rejection**

The Office Action has rejected claims 1-11, 13-21, 23-31 and 33-36 under 35 U.S.C. § 101 as being "directed to non-statutory subject matter." More specifically, the Office Action cites the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* (hereinafter "Guidelines") and argues that claim 1, upon which claims 2-11, 13, and 34-36 depend, and claim 14, upon which claims 15-21 and 23 depend, do not provide a practical application, i.e., that they do not provide a "useful, concrete, and tangible result." However, as indicated in Annex II of the cited Guidelines:

A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases, a claim to a specific machine or manufacture will have a practical application. See *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 ("the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. This is not a disembodied mathematical concept which may be characterized as an 'abstract idea,' but rather a specific machine to produce a useful, concrete, and tangible result."); and *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02 ("the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' - a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent

trades." ). Also see AT&T, 172 F.3d at 1358, 50 USPQ2d at 1452 (Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result without preempting other uses of the mathematical principle.). See Guidelines page 38-39

It should be noted that claims 1 and 14 both recite a specific machine, an identity system. Thus, the applicants argue that, for at least this reason, the process of associating workflows with one or more groups in the identity system is in fact statutory subject matter.

Furthermore, it is well established that the "transformation and reduction of an article 'to a different state or thing' is the clue to patentability of a process claim that does not include particular machines." See Diamond v. Diehr, 450 U.S. 184, 209 USPQ at 7 (quoting Benson, 409 U.S. at 70). It should be noted that claims 1 and 14 both recite in part "performing a first workflow for said task . . . wherein: said first workflow comprises a predefined set of steps that perform said task **to affect the target identity profile**." Thus, even if not limited to a specific machine, claims 1 and 14 would provide a useful, concrete, and tangible result since they recite a transformation of an article, the target identity profile, to a different state. For at least these reasons, the applicants respectfully contend that the rejection is improper and should be withdrawn.

Regarding claim 1, the Office Action also argues that "claim 1 is not recorded on any computer-readable medium, so that even if the practical application requirement were satisfied, the requisite functionality would still not be present." On its face, this statement seems to suggest that, to the contrary a myriad of law cited throughout the Guidelines, a method or process cannot be patentable subject matter unless it is embodied on a computer-readable medium. No citation or support is given in the Office Action for such a requirement. Nor can the applicants find such a requirement in the Guidelines or anywhere else. Rather, it is clear that a process, even if not embodied on a computer-readable medium, can be patentable subject matter. See for example 35 U.S.C. §101, Diamond v. Chakrabarty, 447 U.S. 303, 308-09, 206

USPQ 193, 197 (1980), Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556, and the Guidelines pages 11-14. Thus, the applicants respectfully request clarification of the statement quoted above and/or withdrawal of the rejection.

**35 U.S.C. §103 Rejection, Du in view of SiteMinder**

The Office Action has rejected claims 1-11, 13-21, 23-31 and 33-36 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,041,306, issued March 21, 2000, to Du et al. (hereinafter "Du") in view of Netegrity, Inc., "SiteMinder Policy Server Operations Guide", Version 4.0, published 1997 (hereinafter "SiteMinder"). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP § 706.02(j). However, as will be discussed below, the references cited by the Office Action do not teach or suggest each claimed limitation. For example, neither reference, alone or in combination, teaches or suggests associating workflows with one or more groups in an identity system, receiving a request to perform a task that pertains to at least one identity profile of an entity in said identity system, and performing a first workflow for the task, the first workflow associated with a first group that includes a target identity profile of the request wherein the first workflow comprises a predefined set of steps that perform the task to affect the target identity profile.

Du is directed to "a system and method for performing flexible workflow process execution in a distributed workflow management system." (Col. 2, lines 59-61) Under Du "the distributed workflow management system is formed by a computer network comprising a

plurality of computers." (Col. 3, lines 1-3) "A workflow process management system operates on one or more of the computers to control the computer network in executing the workflow process." (Col. 3, lines 4-7) "Each workflow process includes a sequence of activities, each of which is ordinarily performed by one of the computer systems." (Col. 4, lines 34-36) "The WFPM system provides procedural automation of the workflow process by managing the sequence of process activities and the invocation of appropriate user, machine or microprocessor-controlled device resources associated with the various activity steps." (Col. 4, lines 51-56) That is, Du teaches controlling distribution of processing of tasks between a number of computers in a network. However, Du does not teach or suggest performing a first workflow for a task, the first workflow associated with a first group that includes a target identity profile of the request wherein the first workflow comprises a predefined set of steps that perform the task to affect the target identity profile.

The cited portions of SiteMinder relate to policies and policy domains (p.235-237 and 325-328) and responding to requests for resources (p. 301-304). Under SiteMinder, policies, which may be grouped together into policy domains, control a user's access to resources. Resource within a policy domain, i.e., resource to which a policy domain applies, can be further grouped into realms. Access to the resource is controlled by rules defined for the realm that contains the requested resource. (See pages 235 and 325) However, the cited portions of SiteMinder do not teach or suggest performing a first workflow for a task, the first workflow associated with a first group that includes a target identity profile of the request wherein the first workflow comprises a predefined set of steps that perform the task to affect the target identity profile.

The combination of references are no more relevant to the pending claims than either reference alone since neither Du nor the cited portions of SiteMinder teach or suggest, alone or in combination, performing a first workflow for a task, the first workflow associated with a first group that includes a target identity profile of the request wherein the first workflow comprises a predefined set of steps that perform the task to affect the target identity profile. That

is, neither Du nor the cited portions of SiteMinder teach or suggest, alone or in combination, affecting a target identity profile by performing a workflow associated with a group that contains the target identity profile. Rather Du teaches controlling distribution of processing of tasks between a number of computers in a network while the cited portions of SiteMinder teach controlling user access of resources based on policies applied to groups of resources.

Claim 1, upon which claims 2-11, 13, and 34-36 depend, claim 14, upon which claims 15-21 and 23 depend, and claim 24, upon which claims 25-31 and 33 depend, each recite in part "associating workflows with one or more groups in an identity system, each group including one or more users of the identity system; receiving a request to perform a task that pertains to at least one identity profile of an entity in said identity system; and performing a first workflow for said task, said first workflow is associated with a first group that includes a target identity profile of said request; wherein: said first workflow comprises a predefined set of steps that perform said task to affect the target identity profile, said predefined set of steps comprising a first step and a second step." Neither Du nor the cited portions of SiteMinder teach or suggest, alone or in combination, affecting a target identity profile by performing a workflow associated with a group that contains the target identity profile. Rather Du teaches controlling distribution of processing of tasks between a number of computers in a network while the cited portions of SiteMinder teach controlling user access of resources based on policies applied to groups of resources. For at least these reasons, claims 1-11, 13-21, 23-31, and 33-36 should be allowed.

### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance and an action to that end is respectfully requested.

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PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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Enclosures

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